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09/534,471	03/24/2000	Kenneth A. Parulski	80724PRC	3331
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GROUP 3600

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20070904

Application Number: 09/534,471
Filing Date: March 24, 2000
Appellant(s): Parulski

Frank Pincelli
(Reg. No. 27,370)
For Appellant

EXAMINER'S ANSWER

This examiner's answer has been prepared in response to appellant's brief on appeal
filed April 13, 2007.

(1) *Real Party in Interest*

A statement identifying by name the real party in interest is contained in the brief.

(Eastman Kodak Company)

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. (None.)

(3) *Status of Claims*

The statement of the status of claims contained in the brief is correct.

(Claims 1-6 and 9-19 are pending, rejected, and appealed.)

(Claims 7 and 8 have been cancelled.)

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. (An after-final amendment cancelling claim 8 was submitted on October 30, 2006, and was entered, as indicated in the advisory action mailed November 30, 2006.)

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct:

- I. Whether or not *apparatus* claims 17-19 are unpatentable under 35 U.S.C. 102(b) for being anticipated by Kitagawa et al. (US 5,819,126).
- II. Whether or not *method* claims 1-6 and 9-16 are unpatentable under 35 U.S.C. 103(a) for being obvious over the admitted prior art, in view of Kitagawa et al. (US 5,819,126).

(7) Grouping of Claims

Appellant's statement in the brief that method claims 1-6 and 9-16 do not stand or fall together is not agreed with because appellant fails to explain why the claims of each group are believed to be *separately patentable*, as required by 37 CFR 1.192(c)(7), which states:

For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

Appellant's arguments merely point out differences in the claims, which is *not* an argument as to why the claims are *separately patentable*, as explicitly set forth by rule in 37 CFR 1.192(c)(7).

Therefore, for purposes of appeal, method claims 1-6 and 9-16 should all stand or fall together as a single group (Group II), since appellant's brief does not include *both* a statement that these claims do not stand or fall together *and* (valid) reasons in support thereof.

However, notwithstanding the deficiency of appellant's brief with respect to grouping of claims, the entirety of appellant's arguments have nevertheless been fully considered and addressed hereinbelow, including appellant's separate arguments directed solely to additional elements recited in various claims.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The prior art of record relied upon in the rejection of claims under appeal is as follows:

- Admitted prior art, as described in the specification
- US 5,819,126 Kitagawa et al. 10/1998

(10) *Grounds of Rejection*

I. *Apparatus* claims 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Kitagawa et al. (US 5,819,126).

Kitagawa et al. disclose a camera for capturing images to be provided to a service provider, comprising: (a) means for capturing and storing images; (b) a firmware memory for storing a service identifier which identifies a service account, the service provider account

specifying services to be provided by the service provider; and, (c) means for providing the captured images and the service identifier to the service provider.

Regarding claim 18, the camera of Kitagawa et al. is a film camera, the images are captured and stored using photographic film having at least one magnetic track, and the service identifier is recorded on the at least one magnetic track.

Regarding claim 19, the camera of Kitagawa et al. is an electronic camera including a removable digital memory device, and the images and the service identifier are stored on the removable digital memory device.

II. *Method* claims 1-6 and 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art, as described in the specification, in view of Kitagawa et al. (US 5,819,126).

The admitted prior art, as described by applicant in the specification (for example, from line 13 of page 1, to line 12 of page 3), anticipates all of the substantive elements of the instant invention with regard to a method of sales of customized products, except for disclosing that the particular customized product being offered for sale and selected/created by the customer in the manner of computer systems at dell.com is a camera system being sold for one time use (i.e. "leased"). The admitted prior art further allows that "sales" of such one-time-use (i.e. "leased") cameras is a conventional method in the art, for non-customized cameras.

Kitagawa et al. disclose a camera system which anticipates all of the apparatus features of the instant camera system, as applied above under 35 U.S.C. 102(b), but Kitagawa et al. do not disclose a method of selling customized versions of their camera using a website, nor do they disclose "leasing" their camera (i.e. "selling" it for a one-time use or other limited use).

However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the known method of customized product sales of computers using a website such as dell.com, so as to sell camera systems instead of computer systems, such as the camera system of Kitagawa et al., with the customer selecting particular features in accordance with the known computer sales method, and selling the camera system for a one-time use (i.e. "leased"), as is conventional in the art for non-customized camera systems, so as to increase the profits of a company selling one-time-use cameras by reaching a wider market via the Internet, while satisfying a range of specific market niches by means of customization.

Regarding claims 12-15, storing a customer's photos as digital files and delivering those digital files by means of CD-R, e-mail, or allowing a customer to download the files from a specified Internet location, are all well known, hence, obvious method steps to follow in the art of photographic services. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have further modified the method of sales so as to convert the customer's photos into digital files and deliver those digital files by means of CD-R, e-mail, or allowing a customer to download the files from a specified Internet location, since so doing could be performed by any person of ordinary skill in the art, with neither undue

experimentation, nor risk of unexpected results, merely as a matter of design choice, in order to improve sales even further by offering customers even more photo options.

Additional method claims 1-6 and 16 are drawn to the same invention as claims 9-15.

(11) Response to Argument

I. Apparatus claims 17-19 are unpatentable under 35 U.S.C. 102(b) for being anticipated by Kitagawa et al. (US 5,819,126).

Regarding the argument with respect to apparatus claim 17, that Kitagawa et al. fail to disclose providing a service identifier or a service provider account, and further fail to disclose specifying services to be provided by the service provider, the nature and use of the particular data being written into the device is considered merely an intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In any event, the apparatus of Kitagawa et al. indeed includes the particular claimed usage of providing a service identifier account and services to be provided by the service provider, as the apparatus of Kitagawa et al. pertains to the Advanced Photo System (APS) photography system, which system Kitagawa et al. disclose inherently includes identification

numbers of the user and services to be provided, such as the user specifying, for each individual exposure on the roll of film, the desired size and aspect ratio for printing by the service provider. See, in particular, column 1, lines 1-58.

To the extent that appellant is arguing that the disclosure in Kitagawa et al. is not in as complete detail as is contained in the instant claims, a reference anticipates a claim if it discloses the claimed invention such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention. *In re Graves*, 36 USPQ2d 1697 (Fed. Cir. 1995); *In re Sasse*, 207 USPQ 107 (CCPA 1980); *In re Samour*, 197 USPQ 1 (CCPA 1978).

To the extent that appellant is arguing that the references applied in the rejection fail to use the same names for certain elements as the names used by applicant, the argument is irrelevant, as it is noted that the disclosure in a reference must show the claimed elements arranged in the same manner as in the claims, but need not be in the identical words as used in the claims in order to be anticipatory. See *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

II. Method claims 1-6 and 9-16 are unpatentable under 35 U.S.C. 103(a) for being obvious over the admitted prior art, in view of Kitagawa et al. (US 5,819,126).

Regarding the argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching,

suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).


In this case, the teaching of Dell is merely for the selling of customized products over the Internet. The selling of non-customized cameras over the Internet is admitted to be conventional, and Kitagawa et al. disclose a customized camera having the same particular features and usage as that of the instant invention. Therefore, the motivation to combine is simply to sell cameras such as that of Kitagawa et al. in the customized online manner of Dell rather than in the conventional online manner.

Regarding the arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Furthermore, it has been held that the main test for the tenability of any conclusion of obviousness with respect to any proposed or hypothetical combination or modification of prior art knowledge is *whether or not* such a combination or modification *could have been* performed or implemented by any person of ordinary skill in the art seeking to solve the same problem, at the time of the invention, *with neither undue experimentation, nor risk of unexpected results*. See *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379.

For all of the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,



Gerald J. O'Connor
Primary Examiner
Group Art Unit 3627
9/4/07

GJOC

September 4, 2007

Appeal Conference Held:


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